

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIP O. GERARD

Appeal No. 2004-2256
Application 10/042,738

ON BRIEF

Before GARRIS, PAK, and OWENS, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 1, 3-7 and 9-17. The only other claims remaining in the application, which are rejected claims 18 and 19, have not been made part of the subject appeal; see page 2 of the Brief.

The subject matter on appeal relates to a window frame comprising a first frame half and a second frame half having a

ship orientation and an install orientation with respect to the first frame half, the second frame half being moved between the ship and install orientations by rotating the second frame half within its own plane. According to independent claims 1 and 7, the window frame further comprises a first connector means (see elements 20 and 22 of the appellant's drawing) for releasably interconnecting the first and second frame halves when the second frame half is in the ship orientation and second connector means (see elements 30 and 32 of the appellant's drawing) for securely interconnecting first and second frame halves only when the second frame half is in the install orientation. According to independent claim 13, the window frame further comprises a plurality of barbs (see element 30 of the appellant's drawing) monolithically formed with a first frame half and a plurality of receivers (see element 32 of the appellant's drawing) monolithically formed with the second frame half, each of the receivers receiving one of the barbs only when the second frame half is in the install orientation to securely interconnect the first and second frame halves. This appealed subject matter is adequately represented by independent claims 1 and 13, which read as follows:

1. A window frame comprising:

a first frame half;

a second frame half having a ship orientation and an install orientation with respect to said first frame half, said second frame half being moved between the ship and install orientations by rotating said second frame half within its own plane;

first connector means for releasably interconnecting said first and second frame halves when said second frame half is in the ship orientation, said first connector means being integral with said first and second frame halves; and

second connector means for securely interconnecting said first and second frame halves only when said second frame half is in the install orientation, said second connector means also being integral with said first and second frame halves.

13. A window frame comprising:

a first frame half including a plurality of barbs monolithically formed with said first frame half; and

a second frame half including a plurality of receivers monolithically formed with said second frame half, said second frame half having both a ship orientation and an install orientation with respect to said first frame half, said second frame half being moved between the ship and install orientations by rotating said second frame half within its own plane, each of said receivers receiving one of said barbs only when said second frame half is in the install orientation to securely interconnect said first and second frame halves.

The references set forth below are relied upon by the examiner in the § 102 and § 103 rejections before us:

Hopper	5,570,548	Nov. 5, 1996
Suh	6,272,801	Aug. 15, 2001

Claims 1, 3-7 and 9-12 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hopper according to both the final Office action (i.e., Paper No. 7 mailed September 23, 2003) as well as the Examiner's Answer (i.e., Paper No. 11 mailed June 16, 2004).

Claims 13-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hopper in view of Suh according to the final Office action and as being unpatentable over Suh in view of Hopper according to the Examiner's Answer.¹

¹On page 5 of the Answer, after setting forth the § 103 rejection based on Suh in view of Hopper, the examiner states:

It should be noted that the order in which the references are used [i.e., in the § 103 rejection as set forth in the Answer] is not a new ground of rejection because the rejection above relies on the same teachings of the references as the rejection applied in the [final] Office action of September 23, 2003.

On the record before us including the Reply Brief filed in response to the Examiner's Answer, the appellant has expressed no disagreement with the examiner's determination that the § 103 rejection set forth in the Answer does not constitute a new ground relative to the rejection set forth in the final Office action. Under these circumstances, we will accept, as the appellant implicitly has done, the examiner's aforementioned determination. It follows that, in assessing the merits of the examiner's obviousness position, we will consider both the rationale expressed in the final Office action (i.e., Hopper in view of Suh) and the rationale expressed in the Answer (i.e., Suh

(continued...)

We refer to the Brief and Reply Brief as well as to the final Office action and Answer for a complete discussion of the opposing viewpoints expressed by the appellant and by the examiner respectively concerning these rejections.

OPINION

For the reasons which follow, we cannot sustain the examiner's rejections of the appealed claims.

Concerning the § 102 rejection, it is well settled that anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of the claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Here, it is the examiner's finding that the distal barb of Hopper's barbed flanges (i.e., see elements 35, 36, 38 and 39 of patentee's drawing) corresponds to the first connector means

¹(...continued)
in view of Hopper) as being merely different modes of expressing the same rejection, namely, a § 103 rejection based on the combined teachings of the two applied references.

defined by appealed claims 1 and 7 (e.g., see the paragraph bridging pages 5 and 6, and especially the first full sentence on page 6, of the Answer). However, we agree with the appellant (e.g., see the last paragraph on page 6 of the Brief) that the examiner has not provided an adequate basis for his finding that Hopper discloses, either expressly or under principles of inherency, the claim 1 requirement "first connector means for releasably interconnecting said first and second frame halves when said second frame half is in the ship orientation" or the claim 7 requirement "first connector means unitary with said first and second frame halves for releasably interconnecting said first and second frame halves."

The aforequoted claim limitations are in means-plus-function format. Thus, in accordance with the sixth paragraph of 35 U.S.C. § 112, the examiner must look to the specification and construe the "means" language as limited to the corresponding structure disclosed in the specification and equivalents thereof. In re Donaldson, 16 F.3d 1189, 1194-95, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994). The first step in construing such a limitation is to identify the function of the means-plus-function

limitation. Tex. Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1208, 64 USPQ2d 1812, 1823 (Fed. Cir. 2002), cert. denied, 538 U.S. 1058 (2003). The next step is to identify the corresponding structure in the written description necessary to perform that function. Id. Two structures may be "equivalent" for purposes of § 112, sixth paragraph, if they perform the identical function in substantially the same way with substantially the same result. Kemco Sales, Inc. v. Control Papers Co., Inc., 208 F.3d 1352, 1364, 54 USPQ2d 1308, 1315-16 (Fed. Cir. 2000).

Instead of performing the above described analysis required by the sixth paragraph of § 112, the examiner has simply made the unembellished and implicit determination that the distal barbs of Hopper are equivalent to the pins 20 and sockets 22 disclosed in the appellant's specification and drawing and therefore correspond to the structure embraced by the here claimed first connector means. Similarly, the examiner has implicitly assumed without apparent analysis and certainly without explanation that patentee's barbs perform (or are capable of performing) the claims 1 and 7 function of "releasably interconnecting said first and second frame halves."

It is of course the examiner's initial burden to establish a prima facie case of unpatentability on any grounds including anticipation. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In light of his previously mentioned analytical deficiencies, the examiner has failed to carry this burden in the § 102 rejection before us. Stated differently, the record of this appeal provides no basis for finding that Hopper's barb structure and the function performed thereby are the same as or equivalent to the structure and function defined by independent claims 1 and 7. This deficiency is particularly evident with respect to the requirement in these claims that the first connector means perform the function of "releasably interconnecting said first and second frame halves" (emphasis added). This is because a study of Hopper's disclosure, particularly figures 8 and 10, reveals that patentee's distal barb (which the examiner equates to the here claimed first connector means) would not be capable of performing the "releasably" interconnecting function required by these claims. That is, Hopper's frame construction is such that there appears to be no way to release or disengage his distal barbs

once they have become interconnectingly engaged (even at the initial stage) with the corresponding barbs of connection member 80.

In light of the foregoing, we cannot sustain the examiner's § 102 rejection of claims 1, 3-7 and 9-12 as being anticipated by Hopper.

We also cannot sustain the examiner's § 103 rejection of claims 13-17 as being unpatentable over the combined teachings of the here applied references. Regardless of whether the examiner proposes to modify Hopper in view of Suh as in the final Office action or Suh in view of Hopper as in the Answer, the combined reference teachings simply would not have suggested the modifications which the examiner has proposed to thereby result in the window frame defined by appealed independent claim 13.

More specifically, on page 3 of the final Office action, the examiner concludes that "[i]t would have been obvious to one of ordinary skill in the art to provide Hopper with a barbs [sic], as taught by Suh, to provide a more secure attachment of the first and second frame halves." It is indisputable, however, that the window frame of Hopper already

has barbs. As a consequence, this proposed modification, by itself, clearly would not have remedied the deficiency (e.g., the here claimed receivers and barbs relationship), which the examiner has implicitly acknowledged exists, vis-à-vis the window frame disclosed by Hopper versus the window frame defined by claim 13.

In contrast, it is the examiner's conclusion on page 5 of the Answer that "[i]t would have been obvious to one of ordinary skill in the art to provide Suh with a plurality of barbs and receivers with their attendant install and ship orientations, as taught by Hopper, to more securely connect the frame halves together." The modification here proposed by the examiner is not well taken. As correctly observed by the appellant, the Hopper patent simply does not contain any teaching or suggestion concerning the here claimed ship orientation and install orientation features. It follows that no basis exists for concluding that it would have been obvious to modify the window frame of Suh and thereby yield "install and ship orientations, as taught by Hopper" (id.) pursuant to the examiner's aforequoted obvious conclusion.

For these reasons, we cannot sustain the § 103 rejection of claims 13-17 for being obvious over Hopper in view of Suh as expressed by the examiner in the final Office action or for being obvious over Suh in view of Hopper as expressed by the examiner in the Answer.

REMAND FOR CONSIDERATION OF OTHER ISSUES

Upon return of this application to the jurisdiction of the Examining Corps, the examiner and the appellant should consider and address the issue of whether the window frame of claim 13 is distinguishable from the window frame of Suh's figure 8 embodiment.²

Specifically, the window frame embodiment shown in figure 8 comprises a first frame half 130 including a plurality of posts 162 with ridges 163 and a second frame half 140 including a plurality of bores 165 with ridges 169. These frame

²It is appropriate to here emphasize that the examiner's expositions in the final Office action and in the Answer concerning his § 103 rejection do not include a discussion of Suh's figure 8 disclosure (indeed, the exposition in the Answer refers only to figures 9 and 10 of Suh; e.g., see the last full paragraph on page 4) and do not address the issue of whether claim 13 is anticipated by any of Suh's window frame embodiments.

halves with their posts and bores are indistinguishable from the structure and function of the claim 13 barbs and receivers.

Moreover, these frame halves of Suh are shown in figure 8 in the install orientation defined by claim 13. Finally, it appears to be not just reasonable (see Ex parte Levy, 17 USPQ 1461, 1463-64 (Bd. Pat. App. & Int. 1990)) but indisputable that patentee's frame halves are inherently capable of achieving the here claimed ship orientation. For example, in a pre-connected condition, frame half 140 plainly would be capable of being rotated in its own plane to an orientation of 90° relative to that shown in figure 8. In such an orientation, the frame halves 130 and 140 would be perpendicular to one another and thus in a disposition capable of being regarded as a "ship orientation." Further, the posts/bores (i.e., the here claimed barbs/receivers) would be engageable with each other only when, as required by claim 13, the frame half 140 is rotated back to the install orientation shown in figure 8.

In light of the foregoing, an exploration of the anticipation issue raised herein is deserving of attention by the examiner and the appellant. For this purpose, therefore, we hereby remand this application to the examiner.

Appeal No. 2004-2256
Application 10/042,738

CONCLUSION

In summary, we reverse each of the examiner's § 102 and § 103 rejections, and we remand the application under review to the examiner.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REVERSED AND REMANDED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
)	
)	
)	
CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
TERRY J. OWENS)	
Administrative Patent Judge)	

BRG:psb

Appeal No. 2004-2256
Application 10/042,738

Warner Norcross & Judd LLP
Intellectual Property Practice Group
900 Fifth Third Center
111 Lyon Street, N.W.
Grand Rapids, MI 49503-2487